


CERTIFICATE OF TRANSMISSION BY FACSIMILE (37 CFR 1.8)			Docket No.
Applicant(s): Richard G. Morton			2000-0087-05
Serial No. 09/742,485	Filing Date December 20, 2000	Examiner D. Monbleau	Group Art Unit 2878
Invention: ANNEALED COPPER ALLOY ELECTRODES FOR FLUORINE CONTAINING GAS DISCHARGE LASERS			
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CERTIFICATE OF FACSIMILE TRANSMISSION

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Richard G. Morton

Serial No.: 09/742,485

Filing Date: December 20, 2000

Title: ANNEALED COPPER ALLOY
ELECTRODES FOR FLUORINE
CONTAINING GAS DISCHARGE
LASERS

Examiner: D. Monbleau

Group Art Unit: 2878

Conf. No.: 9464

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450PETITION UNDER RULE 1.181**Introduction**

The above captioned application was determined by the Examiner to be abandoned and the applicant was so notified by a Notice of Abandonment dated January 12, 2005.

Applicant respectfully requests that the Commissioner require the Examiner in the above captioned application to withdraw the holding of abandonment in the above captioned application.

The Examiner determined that an Amended Appeal Brief filed by applicant was non-compliant with the M.P.E.P. §1206.¹ The Examiner determined that the "Summary

¹ The Examiner originally objected to a number of portions of the Appeal Brief which were, apparently, corrected to the Examiner's satisfaction, except for the one issue raised in this Petition.

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of the Invention” section, was not “concise,” i.e., apparently meaning that it is too long in its textual content. The Examiner stated:

Examiner had indicated ... that the brief did not contain a concise explanation of the claimed invention, referring to the specification by page and line number and to the drawing by reference character, as required by MPEP 1206. In response to this, the applicant replaced that section with a *six page explanation of the claimed invention*. While there was reference to the specification by page and line number and to the drawing by Figure numbers, this statement *is no longer concise and contains information that is not the claimed invention*. This section in fact was presented in the original brief that was filed on 4/15/04, to which the Examiner replied with a first Notification of Non-compliance. (Notice of Abandonment, emphasis added)

The Examiner further noted that:

The MPEP 1206 further *requires* ... that ‘where applicable, it is preferable to read the appealed claims on the specification and any drawing.’ Applicant’s newly submitted brief does not comply with this requirement. Applicants Statement of the Invention *is not concise, but rather six pages long, and includes information relating to the prior art device, experimental results and discussion of the overall status/problems of the art*. This *does not enable the Board to more quickly determine where the claimed subject matter is described in the application*.

(Notice of Abandonment, emphasis added)

Applicant respectfully submits that the “Summary of the Invention” section of the Amended Appeal Brief in the above captioned application fully complies with the requirements of the M.P.E.P. §1206, and to submit the kind of “summary” that the Examiner is apparently requesting is potentially prejudicial to applicant’s assignee’s rights in the patent, should one issue in the above captioned application, and such a summary should not be forced upon applicant.

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Argument

The M.P.E.P. simply requires that the Applicant provide a "Summary of the Invention." Such a summary is defined as:

[a] concise statement of the invention defined in the claims involved in the appeal. This explanation is required to refer to the specification by page and line numeral, and if there is a drawing, to the drawing by reference characters.

M.P.E.P. §1206

Applicant respectfully submits that applicant has done precisely this. The Examiner has not objected to anything about the Summary of the invention section of the Amended Appeal Brief other than textual length and the assertion that it, therefore, does not serve the function of directing the Board to the pertinent parts of the specification.

"Concise" in this context is nowhere defined in the M.P.E.P. According to its dictionary meaning, applicant respectfully submits that the "Summary of the Invention" section of the Amended Appeal Brief is "concise", i.e., "marked by brevity of expression or statement: free of all elaboration and superfluous detail." Applicant submits that providing several pages of explanation of the invention and its context in terms of the art and preferable embodiments is concise. Also the citation and quotation of the portions of the specification that contain this discussion satisfy the purposes of the "Summary of the Invention" section in an Appeal Brief as explained in M.P.E.P. §1206, i.e., providing an "explanation" of the claimed invention and directing the Board to pertinent portions of the specification.

M.P.E.P. §1206 goes on to state that:

[w]here applicable it is preferable to read the appealed claims on the specification and any drawing. While reference to page and line number of the specification may require somewhat more detail than simply summarizing the invention, it is considered important to enable the Board to more quickly determine where the claimed subject matter is described in the application.

Applicant submits that the statement of the invention that the Examiner requests, the additional and collateral characterization of the claims, e.g., by reading the claims

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on the specification, is "preferable" only, and not required. There, are, in addition, possibly prejudicial effects of an applicant "*summarizing the invention*" beyond what is already in the record in the disclosure of the specification and language of the claims, which, for lack of a better term, applicant has referred to herein as collateral characterization of the claim meaning. Such collateral characterization has the potential of leading to claim construction adverse to the eventual patent owner's interests. This is ample reason for applicant to respectfully decline to offer such an optional collateral characterization of the claim meaning. Applicant should not be required to submit into the record any additional characterization of the nature of the invention claimed beyond what is in the record in the form of the specification and appended claims, unless in some fashion that record as it exists in the application is not clear.²

Even were this form of summarization by some collateral characterization, e.g., by application of the claim language to the specification, a requirement, which it is not, but only *preferable*, it apparently is not a requirement all of the time. It is "required" only "[w]here applicable." This appears to mean when necessary to "enable the Board to more quickly determine where the claimed subject matter is described in the application."³ Applicant respectfully submits that this apparent objective of M.P.E.P. §1206 has been met in the Amended Appeal Brief on file in the above captioned application. The Examiner has said that this objective is not met, but only because the explanation of the invention quoted from the specification is too long in textual content. Applicant respectfully submits that the length of the text does not get in the way of the presently existing "Summary of the Invention" section of the pending amended Appeal Brief precisely accomplishing the goal of pointing the Board to pertinent explanation of the invention contained in the specification.

² The appropriate place to address such an issue is not at the stage of refusal to accept an Appeal Brief for some objection as to its format and content, but in the substantive arguments of the Appeal Brief, if the issue was raised in the prior prosecution, or else in the Examiner's Answer, to be responded to by the applicant as appropriate in a Reply Brief, and thus to place the issue before the Board.

³ It is actually not very clear from §1206 what "[w]here applicable" means, since the succeeding sentence may be read to refer only to the requirement for citing page and line numbers and not to the reading of the claims on the specification. Does "[w]here applicable" alternatively mean where necessary to explain the meaning of some claim term and/or its support in the specification? Such are not at issue here.

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The Examiner apparently is requesting the applicant to provide some concise or shorthand interpretation of the meaning of the appealed claims, i.e., some collateral characterization of the claims in addition to what the specification and claims of record contain. There is, however, no question here of what the claims mean. The claims speak for themselves. The specification speaks for itself in its explanation of the claimed invention.

Applicant should not be forced to provide the potentially prejudicial claim summary, i.e., collateral characterization of the claim meaning or coverage, e.g., by reading the claim on the specification. Applicant respectfully submits that for reasons of an applicant's choosing an applicant may decide to provide to the Office during prosecution such a collateral characterization of what the claim means or covers or does not cover or the like, but should not be forced to do so. This is especially so when the objectives of the Summary of the Invention section are fully accomplished by referring to selected portions of the specification and in fact quoting them, and there exists the possibility for significant prejudice to applicant's assignee's enforcement of the patent based upon such collateral characterization.

As the C.A.F.C. has noted:

The public notice function of a patent and its prosecution history requires that a patentee be held to what he declares during the prosecution of his patent. ... 'The prosecution history constitutes a public record of the patentee's representations concerning the scope and the meaning of the claims, and competitors are entitled to rely on those representations when ascertaining the degree of lawful conduct Were we to accept [the patentee's] position, we would undercut the public's reliance on a statement that was in the public record and upon which reasonable competitors formed their business strategies.' *Lifestream Diagnostics, Inc. v. Polymer Technology*, 109 Fed.Appx. 411, 414-15 (C.A.Fed. 2004), citing, *Springs Window Fashions LP v. Novo Industries, L.P.*, 323 F.3d 989, 995, 65 U.S.P.Q.2d 1826 (C.A.F.C. 2003), quoting, *Hockerson-Halberstadt, Inc. v. Avia Group Int'l, Inc.*, 222 F.3d 951, 957 (Fed.Cir.2000).

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There is a heavy presumption that the claims mean what they say, absent a clear showing in the record that the patent applicant, in the specification or in the prosecution history, has clearly and unequivocally adopted a special meaning for a claim term or abandoned the meaning of the claim term as covering some embodiment, e.g., as shown in the prior art. See, e.g., *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 874-75, 69 U.S.P.Q.2d 1865 (Fed. Cir. 2004), citing, *Tex. Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202-03 (Fed.Cir.2002); *Inverness Med. Switz. GmbH v. Warner Lambert Co.*, 309 F.3d 1373, 1378 (Fed.Cir.2002); *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1342 (Fed.Cir.2001).

Thus it is the specification of the patent application (and later patent if issued) that is the first place to look for the meaning of the language in the claims, and including their ordinary and usual meaning or any special meaning ascribed to the claim language by the applicant. *Innova/Pure Water, Inc. v. Safari Water Filtration*, 381 F.3d 1111, 1115 (C.A.F.C. 2004)

Beyond these rules of claim construction applicant respectfully submits that, unless the meaning of the claim is in issue, applicant should not be forced to provide some further collateral characterization of a meaning or meaning(s) attributable to the claim language beyond what is already in the record and from which record the Board can fully and adequately evaluate the issues in the pending appeal and determine the appropriateness or lack thereof in the Examiner's substantive prosecution of the appealed claims. Specifically beyond the required "explanation" of the invention, which applicant has provided from the quoted portions of the specification for the claims at issue, applicant should not be required under the optional portion of §1206, e.g., by reading of the claims on the specification or the like form of collateral characterization of the claim meaning(s), to potentially detrimentally be held to have ascribed meaning to claim language beyond what is already in the record.

In addition, applicant respectfully requests the Commissioner to consider the question of whether, in the name of setting forth requirements for the content of an Appeal Brief, the Office should require an applicant to put into the record any form of collateral characterization of the scope and content of the claims, beyond what is

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already in the record in the form of the specification and its appended claims, when not necessary to fulfilling the purposes of the Appeal Brief or necessary for the Board's substantive review of the Examiner's action on appeal, where other applicants not needing to appeal an Examiner's substantive determination, are faced with no such potentially very detrimental requirement. And all of this over a dispute as to what "concise" means in this context.

Conclusions

For the above stated reasons, the Examiner's determination that the amended Appeal Brief was not compliant with M.P.E.P. §1206 was improper. The "Statement of the Invention" in the Amended Appeal Brief is concise and fulfills the spirit and letter of M.P.E.P. §1206. The "more concise" statement that the Examiner seems to require that "summarizes the invention," e.g., by reading claim limitations on specific features contained in the specification is not a requirement, but only "preferable." It is also only "[w]here applicable," which is apparently not the case here since the Board is adequately directed to sufficient portions of the specification that explain what the invention is about and enable interpretation of the claim recitations for purposes of evaluating the Examiner's substantive determinations on appeal. And for this reason also, the Examiner's statement that the "Summary of the Invention," fails to point out these portions of the Specification to so enlighten the Board is simply not correct.

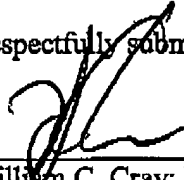
Finally, applicant respectfully submits that applicant should not be required to submit the kind of collateral characterization of the claim meaning, beyond what is already in the record in the form of the application specification and claims, where to do so is potentially of prejudicial effect in the future should the patent issue, and there is no reason to force applicants who find appeal necessary to do so when other applicants are not.

Applicant therefore respectfully requests that the Commissioner grant the present Petition and instruct the Examiner to withdraw the Notice of Abandonment in the above captioned application and proceed to the preparation of the Examiner's Answer in the pending appeal in the above captioned application.

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Applicants do not believe that any fees are due for the filing of this Petition. In the event that any fees are due by this filing, Applicants hereby authorize the Commissioner to charge or credit the Deposit Account of Cymer, Inc., Deposit Account 03-4060 for any such fees.

Respectfully submitted,



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January 24, 2005
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